Remarks

The Examiner is thanked for his time during a teleconference with Applicant's representative on August 12, 2004.

Reconsideration of this Application is respectfully requested.

Claims 4-6, 8, 9, and 12. Claims 1-12 are pending in the application, with 1 being the independent claim. No new matter has been entered by any amendments.

Based on the above amendment and following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 1-12 were rejected as being indefinite for the use of "variable wave plate" in claim 1. Applicant has found 42 patents using this exact term in either their specification or claims dating back to 1985, and more specifically 8 patents using this exact term in their claims.

A term is not vague if one of ordinary skill in the art would understand its meaning in the context of the claim. At least based on the usage of the term in the instant specification and the usage of the term in the above-noted prior patents, Applicant submits that a prima facie case of indefiniteness under 35 U.S.C. § 112, second paragraph, has not been met by the Examiner. See, M.P.E.P § 2173.02, stating in relevant part (emphasis added) "Definiteness of a claim **must** be analyzed, **not in a vacuum**, but in light of: (A) The content of the particular application disclosure,; (B) The teachings in the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary skill in the pertinent art at the time the invention was made." and M.P.E.P. § 2173.04, stating in relevant part "Breadth of a claim is note to be equated with indefiniteness." Even assuming the prima facie case was met by the Examiner, it has been sufficiently rebutted by Applicant in this Reply.

Moreover, based on at least the 8 patents having this term in their claims, and their claims being presumed valid under 35 U.S.C § 282, this term has been seen as

being definite by the U.S. Patent Office. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

Claims 4, 8, 9, and 12 were rejected as being incomplete for not including essential structural cooperative relationships of the recited elements. Although the Applicant disagrees with the Examiner regarding the need under 35 U.S.C. § 112, second paragraph, for such "structural cooperative relationships," Applicant has amended the claims in order to expedite prosecution. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections.

Claims 5 and 6 were rejection as being vague and indefinite. Although the Applicant disagrees with the Examiner, Applicant has amended the claims in order to expedite prosecution. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections.

Rejections under 35 U.S.C. § 103(a)

Claim 1 was rejected under 35 U.S.C. § 103(a) ("103") as being unpatentable over U.S. Patent No. 5,715,084 to Takahashi et al. ("Takahashi") in view of U.S. Patent No. 5,593,606 to Owen et al. ("Owen). Claim 2 was rejected under 103 as being unpatentable over Takahashi in view of Owen in further view of U.S. Patent No. 5,593,606 to Zhang et al. ("Zhang"). Claim 3 was rejected under 103 as being unpatentable over Takahashi in view of Owen in further view of U.S. Patent No. 4,342,517 to Johnson et al ("Johnson"). Applicant traverses these rejections.

Claim 1 recites at least "wherein the reticle is positioned along an axis of a light beam path between a source of the light beam and the first optical device, and wherein the variable wave plate is positioned along the axis adjacent the reticle and between the source of the light beam and the first optical device."

In regards to "a first optical device," as recited in claim 1, in order to apply Takahashi to claim 1, the Examiner asserts elements 5 and 6 in Figure 1 of Takahashi form a first optical device. However, it is clear from Takahashi element 2 is a first optical device, which is taught at least at col. 3, lines 20-22 "Divergent light from the illuminated reticle 1...is received by a first lens group 2...The first lens group 2... ."

Thus, when viewing the light path traveled by a light beam (i.e., being from left to right in Figure 1 of Takahashi), after leaving reticle 1 a first optical device that light interacts with is first lens group 2, and not elements 5 and 6 as asserted by the Examiner. This is also supported at least at col. 3, line 28, where Takahashi teaches element 5 to be "a second lens group 5." Therefore, the assertion by the Examiner that elements 5 and 6 in Takahashi are a first optical device is contradictory to the clear teaching of Takahashi.

In regards to "the variable wave plate is positioned along the axis adjacent the reticle," as recited in claim 1, the Examiner asserts "adjacent" means nearby, and that quarter wave plate 4 is nearby reticle 1, thus it is adjacent reticle 1. In TI Group Automotive Systems, Inc. v. VDO North America LLC., 375 F.3d 1126, 71 U.S.P.Q.2d 1328 (Fed. Cir. 2004), the Federal Circuit held a common theme of multiple dictionary definitions must be used to construe claims terms. Applicant has found the following dictionary definitions (see attached copy of Webster's II New Riverside Dictionary Revised Edition and a printout from August 17, 2004 at http://dictionary.reference.com/search?q=adjacent): (1) close to, lying near; (2) next to; adjoining; (3) lying near, close, or contiguous; neighboring; bordering on; (4) nearest in space or position; immediately adjoining without intervening space; (5) having a common boundary or edge; touching; (4) near or close to but not necessarily touching; (6) close to; nearby; and (7) next to; adjoining. From these dictionary definitions, it would appear that to be "adjacent" two elements, in claim 1 a reticle and variable wave plate, would have to be almost touching in order to meet a common theme of the above definitions, as is required by law. This is clearly not taught or suggested in Takahashi because element 4 would not be considered almost touching element 1 in Figure 1.

None of the other patents applied by the Examiner cure the deficiencies of Takahashi. Therefore, at least "wherein the reticle is positioned along an axis of a light beam path between a source of the light beam and the first optical device, and wherein the variable wave plate is positioned along the axis adjacent the reticle and between the source of the light beam and the first optical device," as recited in claim 1, is neither taught or suggested by Takahashi either singly or in combination with any of the other applied patents. Accordingly, Applicant respectfully requests that the Examiner

reconsider and withdraw the rejection. Also, at least based on their dependency to claim 1, claims 2-3 should also be found allowable over the applied patent.

Rejection under the judicially created doctrine of Obviousness-Type Double Patenting

Claims 1-12 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent 6,680,798. Although Applicant disagrees with this rejection, Applicant is obtaining a Terminal Disclaimer, which should be timely filed subsequent to this Reply. The Examiner is asked to contact Applicant's representative if the Terminal Disclaimer has not yet been received and the only outstanding rejection is this rejection before sending another Office Action.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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